

REMARKS

In the Non-Final Office Action, the Examiner rejected claims 1-10, 12, 13, 47-69, and 71-78. By this paper, Applicants cancelled claim 70. Upon entry of this amendment, claims 1-10, 12, 13, 47-69, and 71-78 will be pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendment and following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejection under 35 U.S.C. § 112

In the Non-Final Office Action, the Examiner rejected claims 1-10, 12, 13, 47-69, and 71-78 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

Legal Precedent

Regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable? *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art

without undue experimentation. *U.S. v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991).

Deficiencies of the Rejection

In the Response to Final Office Action mailed January 30, 2008, Applicants attached a schematic (http://www.spiraxsarco.com/images/resources/steam-engineering-tutorials/6/5/fig6_5_01.gif) showing a valve plug having a curved surface that could provide a linear flow characteristic for the associated valve. The purpose of the attachment was to depict that a curved surface of a valve plug could produce a linear flow characteristic. In the present Office Action, the Examiner provided additional information from the tutorial at the website having that schematic. In formulating the present rejection, the Examiner asserted that the valve plug of FIG. 9A of the present application would produce a linear flow for “Curve 1” of the plug, but would produce a fast opening behavior for “Curve 2” of the plug. *See* Office Action, pages 2-5.

However, in a phone discussion between the Examiner and the undersigned on December 11, 2008, the Examiner agreed that the geometry of the surface of the valve plug depicted in FIG. 9A could produce a bilinear flow characteristic. More particularly, it was discussed that Curve 1 could produce a linear flow (i.e., with a low slope) and that Curve 2 could produce a linear flow (i.e., with a higher slope as a linear portion of the fast

opening behavior). In the phone discussion, the undersigned suggested that Applicants would consider clarifying amendments to specification, but the Examiner stated he thought such amendments to be unnecessary at this time. Lastly, Applicants noted that FIGS. 9 and 9A are general representations, and that in view of the present specification, one of ordinary skill in the art would be able to specify and make or obtain a valve having the particular desired bilinear flow characteristic for a given control application without undue experimentation. In view of the foregoing, the Examiner agreed to consider withdrawal of the present rejection. Applicants thank the Examiner for the helpful phone discussion. Applicants respectfully request the Examiner withdraw the rejection and allow the claims.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge fees for any extensions of time, or for any other reason needed to advance prosecution of the present application, to Deposit Account No. 06-1315; CPCM:0010.

Respectfully submitted,

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